



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/869,425	06/27/2001	Hiroaki Arita	3273-0142P	3973

2292 7590 09/16/2003

BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

14

EXAMINER

RAJGURU, UMAKANT K

ART UNIT	PAPER NUMBER
----------	--------------

1711

DATE MAILED: 09/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/869,425

Applicant(s)

ARITA, HIROAKI

Examiner

Umakant K. Rajguru

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1711

1. An appeal brief (Paper No. 13) has been filed on June 11, 2003.

2. Claims under appeal are 1-6.

NR 3. Rejection of claims 1-6 under 35 USC 103(a) (see item 5 in paper 7, and ^{*papers*} 9 and 12) is now withdrawn.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites a thermoplastic elastomer as one having a soft segment composed of a polyether or polyester. This claim depends from claim 1. Claim 1 encompasses only a polyamide-based elastomer (not a polyetheramide or polyester amide). Hence claim 3 is indefinite in reciting polyether or polyester.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 4-6 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishicawa et al (US 3,915,912).

Art Unit: 1711

Ishicawa discloses polyamide compositions containing a polyethylene glycol derivative (abstract). Polyethylene glycol is present at 0.5% by wt. or more (column 1, lines 51-57).

Claims 1 and 4-6 therefore lack novelty.

7. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

8. Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishicawa et al (US 3,915,912).

Disclosure of Ishicawa is presented in short above. It would have been obvious to follow teachings of this patentee and arrive at claimed invention.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ishicawa et al (US 3,915,912) as applied to claim 1 above, and further in view of Takashige et al (US 5,716,696).

Ishicawa does not mention anything about soft segment of polyamide.

According to Takashige, polyamide elastomer DI-AMIDE-PAE has a soft segment such as a polyether component (column 3, lines 51-56). Incidentally, instant invention uses DI-AMIDE PAE (see specification page 10, line 11).

Therefore it would have been obvious that the polyamide of Ishicawa possesses a self-segment of polyether.

10. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rajagopalan (US 6,121,384).

Art Unit: 1711

Rajagopalan discloses compositions for cover of golf ball. Such a composition comprises a polymer prepared from three monomer components (column 10, lines 59-67). Some other polymers, including block poly (ether-amide) copolymers can also be used (column 13, lines 13-15). One of the important properties of the composition is enhanced impact resistance (column 3, line 53; column 6, lines 66-67).

Rajagopalan does not mention the addition of glycol to the composition.

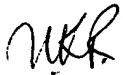
Disclosure of Ishicawa is presented earlier.


It would have been obvious to add the glycol (of Ishicawa) to the composition of Rajagopalan to obtain enhanced moldability.

11. Any inquiry concerning this communication from the examiner should be directed to U.K. Rajguru whose telephone number is 703-308-3224. The examiner can generally be reached on Monday-Friday 9:30 am-6:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 703-308-2462. The fax phone numbers for the organization where this application is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-0661.


U.K. Rajguru/dh
September 12, 2003


James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700